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Norman Muttitt

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EXAMINER

NASH, LASHANYA RENEE

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/014,450	Applicant(s) MUTTITT ET AL.	
	Examiner LaShanya R. Nash	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to an Amendment filed August 9, 2006. Claims 1-28 are presented for further consideration. Claims 1,7,13,19-21 and 25-26 are currently amended.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 9, 2006 has been entered.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In considering the Applicant's argument the following factual remarks are noted:

(I) Applicant contends that the prior art, (i.e. Bennett) fails to disclose generating an e-mail for each one of a plurality of patrons wherein the e-mail contains multiple pieces of content and each piece of content corresponds to a distinct campaign.

In considering (II), Applicant contends that Bennett fails to disclose generating an e-mail for each one of a plurality of patrons wherein the e-mail contains multiple pieces

of content and each piece of content corresponds to a distinct campaign. Examiner respectfully disagrees. Examiner asserts that Bennett explicitly discloses and further promotes the "synergy" between different merchants, wherein the clearinghouse mechanism facilitates communications from both merchants to an identified shared patron creating cross-merchant marketing opportunities (paragraph [0018], lines 1-8). Bennett additionally discloses employing e-mails for communicating the aforementioned combined cross-merchant campaigns to an overlapping patron (paragraph [0018], lines 8-14). In a specific cross-merchant example, Bennett discloses presenting a communication to a patron wherein the communication merges the campaigns of both a restaurant and a movie rental merchant (i.e. dinner and a movie; paragraph [0074]). As a result, Examiner asserts that Bennett both teaches and suggests matching a patron to multiple active campaigns of associated patron-relevant merchants, and subsequently generating an e-mail merging the distinct campaigns for the patron (paragraph [0086]). Therefore, Examiner maintains that Bennett discloses all limitations of rejected claims, as set forth below in the Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2,7-8,13-14, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett et al. (US Patent Application Publication 2001/0032137), hereinafter referred to as Bennett.

In reference to claim 1, Bennett discloses a method for distribution of targeted and highly personalized emails (abstract), which comprises:

- A method implemented by a computer for providing combining multiple pieces of content (i.e. cross-merchant marketing; paragraphs [0018], [0074]) to be provided to at least one of a plurality of patrons, (abstract and paragraph [0008], line 1 to paragraph [0009], line 21), the method comprising:
 - Maintaining a database identifying each of the patrons and each patron's corresponding interest, (paragraph [0034], line 1 to paragraph [0036], lines 25 and paragraph [0042], lines 1-17);
 - Matching the multiple pieces of content to a patron based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9);
 - Generating by the computer (i.e. clearinghouse; Figure 1-item 24) an e-mail for the patrons, wherein the e-mail contains the multiple pieces of content (paragraph [0086]), each piece of content corresponding to a distinct campaign (i.e. cross-merchant marketing; paragraphs [0018], [0074]); and delivering the e-mail to each of the patrons, (paragraph

[0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 7, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for combining multiple pieces of content (i.e. cross-merchant marketing; paragraphs [0018], [0074]) to be provided to at least one of a plurality of patrons (abstract and paragraph [0008], line 1 to paragraph [0009], line 21), the system comprising:
 - Means for (Figure 1-item 24) maintaining a database (Figure 1-item 23) identifying each of the patrons and each patron's corresponding interest, (paragraph [0012], lines 1-11; paragraph [0036], lines 1-25; and paragraph [0042], lines 1-17);
 - Means for (Figure 1-item 24) matching the multiple pieces of content to a patron based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730, line 1 to paragraph [0074], line 17);
 - Means for (Figure 1-item 24) generating an e-mail (Figure 1-item 27) for the patron, wherein the e-mail contains the multiple pieces of content (paragraph [0086]), each piece of content corresponding to a distinct campaign (i.e. cross-merchant marketing; paragraphs [0018], [0074]); and means for delivering the e-mail to the patron, (paragraph

[0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 13, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for combining multiple pieces of content in an e-mail, (i.e. cross-merchant marketing; paragraphs [0018], [0074]), (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 1), the system comprising:
 - A processor (Figure 1-item 24) programmed to:
 - Maintain a database (Figure 1-item 23) identifying each of a plurality of patrons and each patron's corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730, line 1 to paragraph [0074], line 17);
 - Match the multiple pieces of content to each of the patrons based on each patron's individual corresponding interest, (paragraph [0066], line 1 to paragraph [0069], line 9; and paragraph [00730, line 1 to paragraph [0074], line 17);
 - Generate the single e-mail (Figure 1-item 27) for each of the patrons, wherein the e-mail contains the multiple pieces of content (paragraph [0086]), each piece of content corresponding to a distinct campaign (i.e. cross-merchant marketing; paragraphs [0018], [0074]); and a subsystem programmed to deliver the e-mail to each of the patrons,

(paragraph [0077], line 1 to paragraph [0082], line 3 and paragraph [0086], line 1 to paragraph [0088], line 12).

In reference to claim 19, Bennett discloses a system employed for distribution of targeted and highly personalized emails (abstract), which comprises:

- A system for combining multiple pieces of content in an e-mail, (i.e. cross-merchant marketing; paragraphs [0018], [0074]), (abstract; paragraph [0008], line 1 to paragraph [0009], line 21; and Figure 10), the system comprising:
- A content management subsystem (i.e. Figure 10 items 23 and 232; main database and ready contact), wherein the content management subsystem is adapted to receive content as input and is adapted to deploy the content into a first database, (paragraph [0091], lines 1-9);
- A datamart subsystem (i.e. Figure 10-item 244; campaign filter), wherein the datamart subsystem is adapted to extract content from the first database (Figure 10-item 23) and one or more other databases (Figure 10-item 238 and 240) and is adapted to match a plurality of patrons to a single piece of content, based on each patron's corresponding interest, (paragraph [0091], lines 9-16);
- A targeted e-mail application subsystem (i.e. Figure 10-item 244; campaign filter), wherein the targeted e-mail application subsystem is adapted to merge each single piece of content matched to each of the plurality of patrons, so as to provide targeted e-mails (paragraph [0086]), each targeting e-mail having multiple pieces of content for each of the plurality of patrons, (paragraph [0091],

lines 9-16), each piece of content corresponding to a distinct campaign (i.e. cross-merchant marketing; paragraphs [0018], [0074]); and

- An e-mail vendor subsystem (Figure 10-item 230; e-mail send queue), wherein the e-mail vendor subsystem is adapted to distribute a targeted e-mail to each of the plurality of patrons, (paragraph [0091], lines 16-35).

In reference to claims 2,8,14, and 20 Bennett shows the target e-mail method and system further comprising prioritizing the multiple pieces of content for placement (i.e. merging) in the e-mail, (paragraph [0086]).

In reference to claims 25 and 27, Bennett shows the method and system comprises maintaining a database identifying each of the patron's behavior (i.e. information storage unit in communication with patron identification device; paragraphs [0037]-[0038]); and the matching further comprising matching the multiple pieces of content to each of the patrons based on the patron's behavior, (paragraphs [0054]-[0073]).

In reference to claims 26, Bennett shows the method wherein the behavior identified includes at least one of flight behavior and website behavior, (i.e. merchant website paragraph [0037]; paragraphs [0054]-[0073]).

In reference to claim 28, Bennett shows the system wherein the datamart subsystem is further adapted to match a plurality of patrons to a single piece of content based on patrons' behavior, (paragraphs [0054]-[0073]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 9-10, 15-16 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied to claims 1,7,13, and 19 above, in view of Mindrum (US Patent 4,723,212), hereinafter referred to as Mindrum.

In reference to claims 3,9,15, and 21 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising limiting the number of pieces of content to be provided in the e-mail. However, this limitation was well known in the art at the time of the invention, as further evidenced by Mindrum. Therefore it would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett.

In an analogous art, Mindrum discloses a method for electronically dispensing merchant provided content (i.e. coupon), wherein the number of coupons per transaction is limited, (abstract). One of ordinary skill in the art would have been so motivated to implement this modification so as to raise the potential for creating new

customers, and thereby increasing system effectiveness for merchants, (Mindrum column 1, lines 60-65).

In reference to claims 4, 10, 16, and 22 Bennett shows the target e-mail method and system, further comprising eliminating duplicate pieces of content, (paragraph [0042], lines 1-13).

Claims 5, 11, 17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett as applied to claims 1, 7, 13, and 19 above, in view of Kamakura (US Patent 6076101), hereinafter referred to as Kamakura.

In reference to claims 5, 11, and 23 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising sorting the multiple pieces of content into defined categories. However, this limitation would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett, as further evidenced by Kamakura.

In an analogous art, Kamakura discloses an electronic mail processing method and system that generates consumer-interest based target emails, wherein the email content is organized into defined categories, (column 4, lines 37-51). One of ordinary skill in the art would have been so motivated to implement this modification so as to improve the organizational arrangement of targeted email content, and thereby increasing system ease of use for consumers/email recipients, (Kamakura column 1, lines 57-60).

Claims 6,12,18, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Kamakura (US Patent 6076101), hereinafter referred to as Kamakura, and further in view of Mindrum.

In reference to claims 6,12, and 24 although Bennett shows substantial features of the claimed invention, the reference fails to show the target email method and system further comprising sorting the multiple pieces of content into defined categories. However, this limitation would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett, as further evidenced by Kamakura.

In an analogous art, Kamakura discloses an electronic mail processing method and system that generates consumer-interest based target emails, wherein the email content is organized into defined categories, (column 4, lines 37-51). One of ordinary skill in the art would have been so motivated to implement this modification so as to improve the organizational arrangement of targeted email content, and thereby increasing system ease of use for consumers/email recipients, (Kamakura column 1, lines 57-60). Bennett and Kamakura fail to show limiting number of pieces of content within the e-mail categories. However, this limitation was well known in the art at the time of the invention, as further evidenced by Mindrum. Therefore it would have been an obvious to one of ordinary skill in the art at the time of the invention to accordingly modify the modification to the system and method as disclosed by Bennett and Kamakura.

In another analogous art, Mindrum discloses a method for electronically dispensing merchant provided content (i.e. coupon), wherein the number of coupons per transaction is limited, (abstract). One of ordinary skill in the art would have been so motivated to implement this modification so as to raise the potential for creating new customers, and thereby increasing system effectiveness for merchants, (Mindrum column 1, lines 60-65).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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LaShanya Nash

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October 17, 2006



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